

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of : Customer Number: 46320

Dennis KING : Confirmation Number: 2350

Application No.: 09/407,141 : Group Art Unit: 2626

Filed: September 28, 1999 : Examiner: L. Spooner

For: REUSABLE CONTROLS FOR AUTOMATICALLY TRANSLATING TEXT  
BETWEEN LANGUAGES

**REPLY BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated May 14, 2008.

The Examiner's response to Appellant's arguments submitted in the Appeal Brief of February 5, 2008, raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellant relies upon the arguments presented in the Appeal Brief of February 5, 2008, and the arguments set forth below.

## **REMARKS**

Appellant has compared the statement of the rejection found on pages 5-8 of the Examiner's Answer with the statement of the rejection found on pages 5-7 of the Eighth Office Action. Upon making this comparison, Appellant has been unable to discover any substantial differences between the respective statements of the rejection. As such, Appellant proceeds on basis that the Examiner's sole response to Appellant's Appeal Brief is found on pages 8-11 of Examiner's Answer.

On page 4 of the Appeal Brief, Appellant pointed out where the Examiner's Answer is required to include particular content, yet the Examiner has completely ignored this requirement. noted throughout the prosecution of this application and in the Appeal Brief, the Examiner failed to properly establish the facts underlying the Examiner's analysis. Appellant's position that these omissions in the Examiner's *prima facie* analysis are correctable by the Examiner, the correction of these omissions would help both Appellant and the Board gain a better understanding of the underlying facts and analysis employed by the Examiner in rejecting the claims. Thus, Appellant respectfully recommends that the Board remand the present application the Examiner to address these omissions.<sup>1</sup>

<sup>1</sup> The Board has persistently declined to uphold an Examiner because of omissions in the Examiner's half of the record. *E.g.*, *Ex parte Daleiden*, Appeal 2007-1003 (Mar. 14, 2007) (remanding because examiner failed to respond to arguments in the Appeal Brief); *Ex parte Rozzi*, 63 USPQ2d 1196, 1200-03 (BPAI 2002) (McKelvey, J.) (remanding without decision because of a host of examiner omissions and procedural errors); *Ex parte Gambogi*, 62 USPQ2d 1209, 1212 (BPAI 2001) (McKelvey, APJ) ("We decline to tell an examiner precisely how to set out a rejection."); *Ex parte Jones*, 62 USPQ2d 1206, 1208 (BPAI 2001) (McKelvey, APJ) (refusing to adjudicate an issue that the examiner has not developed); *Ex parte Schrieker*, 56 USPQ2d 1723, 1725 (BPAI 2000) ("The examiner has left applicant and the board to guess as to the basis of the rejection ... We are not good at guessing; hence, we decline to guess."); *Ex parte Bracken*, 54 USPQ2d 1110, 1112-13 (BPAI 1999) (McKelvey, APJ) (noting that the appeal is "not ripe" because of omissions and defects in the examiner's analysis).

1        In response the arguments presented on pages 5 and 6 of the Appeal Brief with regard to  
2        the term "reusable control," the Examiner responded as follows in the paragraph spanning pages  
3        8 and 9 of the Examiner's Answer:

4        The Examiner notes as previously cited, Haman teaches, Fig. 2 item 52, an object as a control (see  
5        C.8 lines 4, 5), which is furthermore distributable, to multiple applications (C.4 lines 58-60)., this  
6        particular framework is distributable to other applications. Therefore, as applicant only described  
7        once within the specification, a reusable control, p.7 paragraph 1, "The developer will then create  
8        the form of Figure 2 using know techniques, however, the controls will be MT aware controls. As  
9        block 430 parameters (within the reusable controls) are initialized...", the Examiner is able to  
10       conclude based upon the teachings of Hamann, such distributable controls are sufficient to meet  
11       and define applicant's claimed usable controls.

12

13        Despite Appellant's arguments in the paragraph spanning pages 5 and 6 of the Appeal  
14        Brief, the Examiner's analysis still fails to include a claim construction for the term "reusable  
15        control" accompanied by an explanation as to how this claim construction reflects the broadest  
16        reasonable interpretation of the term consistent with Appellant's specification. "Both  
17        anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in  
18        both analyses is a proper construction of the claims. . . . The second step in the analyses requires  
19        a comparison of the properly construed claim to the prior art."<sup>2</sup> Without such a claim  
20        construction, Appellant has not been given a fair opportunity to evaluate the Examiner's analysis,  
21        and the Examiner has erred by failing to properly analyze the claims.

22

23        Items 50, 52, 54 in Hamann, which were referred to by the Examiner, are objects in  
24        which a source language text item associated with the object has been replaced with a  
25        corresponding target language text item (see column 4, lines 51-56). As described in column 4,  
26        lines 65-67, examples of these objects are:

27        check boxes, drop down list boxes, drop down picture list boxes, edit masks, group boxes, list  
28        boxes, picture list boxes, radio buttons, single line edits, static text, and tree views.

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<sup>2</sup> Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

1 Referring to claim 1, the method is performed with the reusable control (i.e., the reusable data  
2 object), and the initializing and identifying steps are encapsulated to make the reusable data  
3 object. However, as will be discussed in relation to the Examiner additional comments, the  
4 Examiner is not relying upon items 50, 52, 54 to teach these limitations.

5

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6

7 In response to Appellant's arguments on pages 6 and 7 of the Appeal Brief as to the text  
8 to be translated is in a field of the control and the text is either inputted into the field or outputted  
9 from the field, the Examiner asserted the following in the first full paragraph on page 9 of the  
10 Examiner's Answer:

11

12 In response to applicant's arguments, p.6 lines 15-17 "the text to be translated is in a field  
13 of the control and the text is either inputted into the field or outputted from the field." It is evident,  
14 that there is text in the control of Hamann, (see Fig. 2, item 52 "OVERT FERME" which are text  
15 items, these text items, "open" and "close" in English, see C.8 lines 30-31, are items of text that inherently were input into the field, the Examiner notes there is no other way for the text to be  
16 found in the field of the control, other than at some point in time, be input into the field), it is  
17 further evident that there is text outputted from the field, by visual inspection (see above Fig. 2  
18 discussion). Therefore, it is sufficient to note that Hamann teaches text "inputted or outputted from  
19 the field." (emphasis added)

20

21 The Examiner now admits that the limitations at issue are not explicitly disclosed by Hamann.  
22 Instead, the Examiner newly presents assertions that these limitations are inherently disclosed by  
23 Hamann.

25

26 Appellant submits that the Examiner's reliance upon the doctrine of inherency to disclose  
27 the features at issue is misplaced. Inherency may not be established by probabilities or  
28 possibilities. The mere fact that a certain thing may result from a given set of circumstances is

1 not sufficient to establish inherency.<sup>3</sup> To establish inherency, the extrinsic evidence must make  
2 clear that the missing element must necessarily be present in the thing described in the reference,  
3 and that the necessity of the feature's presence would be so recognized by persons of ordinary  
4 skill.<sup>4</sup> Furthermore, reference is made to ex parte Schricker,<sup>5</sup> in which the Honorable Board of  
5 Patent Appeals and Interferences stated the following:

6 However, when an examiner relies on inherency, it is incumbent on the examiner to point to the  
7 "page and line" of the prior art which justifies an inherency theory. Compare, In re Rijckaert, 9  
8 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an  
9 explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or  
10 suggestion appears in the prior art); In re Yates, 663 F.2d 1054, 107, 211 USPQ 1149, 1151  
11 (CCPA 1981).

12 The Examiner did not discharge that burden of indicating where such a teaching appears in the  
13 prior art. Thus, the Examiner has not established that this limitation is inherently disclosed by  
14 Hamann.

16  
17 As to the Examiner's argument that "there there is no other way for the text to be found in  
18 the field of the control, other than at some point in time, be input into the field" reflects a  
19 fundamental misunderstanding, by the Examiner, as to what elements constitute a user interface  
20 (see column 8, lines 5-6, "each of the objects 50, 52, 54 that make up the user interface of the  
21 application program").

22  
23 When the Honorable Board prepares the decision as to this Appeal, the decision will  
24 likely be written upon a word processing program, which includes a multitude of user interfaces,

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<sup>3</sup> In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

<sup>4</sup> Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

<sup>5</sup> 56 USPQ2d 1723, 1725 (BPAI 2000).

1 such as described in column 4, lines 65-67 of Hamann. As is readily apparent upon use of these  
2 user interfaces, the text within these user interfaces are not fields into which text is inputted.  
3 Instead, the text for a particular user interface has been predefined for the particular user  
4 interface. The thrust of the teachings of Hamann is to take the predefined text found in a  
5 particular object (e.g., a user interface) and to translate that text into another language. For  
6 example, following the teachings of Hamann, the word processing program, having user  
7 interfaces that are all in English, could be modified such that the user interfaces are all in French.  
8

9       However, upon the user interface accepting a text input within a field (not all user  
10 interfaces accept text input), Hamann fails to teach that object making up the user interface  
11 initializes parameters to identify a plurality of variables comprising at least the source and the  
12 target language and identify when translation should be invoked for text in a field of the control.  
13 Instead, Hamann is concerned about translating text that is part of the object and not text which  
14 is input into a field of the object. Thus, for the reasons submitted above, the Examiner's  
15 inherency argument is misplaced.  
16

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17       On pages 7 and 8 of the Appeal Brief, Appellant presented arguments regarding the  
18 encapsulation of the initializing and the embedding steps. The Examiner's response is found in  
19 the paragraph spanning pages 9-11 of the Examiner's Answer, and rather than reproducing the  
20 response in its entirety, Appellant will separately address portions of the response.  
21

22  
23

1 Initially, the Examiner asserted the following

2 In response to applicant's arguments, p.7 and p. 8, applicant argues, that "The translator  
3 48 of Hamann does not perform the initializing parameters." The Examiner notes the applicant  
4 does not claim a translator that initializes parameters. Furthermore, the Examiner notes that the  
5 applicant does not mention or define encapsulation anywhere in the specification. Furthermore, the  
6 Examiner notes, as stated above, Hamann teaches a translator, an embedded translator, a  
7 distributable, packaged translator, which comprises a system of components for (see previously  
8 cited C.7.lines 54-60-C.4.lines 33-38-his embedded translator includes encapsulation of the  
9 initializing and identifying steps, C.4 lines 51-60-which discusses an "encapsulated" translator, see  
10 the system of Fig. 2, as interpreted as packaged), thus this preponderance of evidence points to  
11 encapsulation.

12  
13 Appellant's arguments regarding the translator 48 of Hamann were in response to the Examiner's  
14 prior assertion that "his embedded translator includes encapsulation of the initializing and  
15 identifying steps." Thus, Appellant has every right to argue that a feature that the Examiner is  
16 alleging to disclose particular features, in fact, does not disclose these features. The fact that the  
17 claims do not recite a translator is immaterial when the Examiner is relying upon the translator  
18 48 of Hamann to identically disclose certain features.

19  
20 Regarding the Examiner's comments about defining encapsulation, as previously noted  
21 above, the Examiner is tasked with performing a claim construction, a task which the Examiner  
22 has again failed to perform. As for the Examiner's of column 4, lines 51-60, this citation  
23 exemplifies why Hamann fails to identically disclose the claimed invention. The Examiner is  
24 alleging the translator performs the initializing and identifying steps. However, the Examiner's  
25 cited passage does not teach that the initializing and identifying steps are encapsulated in the  
26 reusable data object. Instead, what the Examiner cited passage teaches is that the results of the  
27 translation could be considered as being "encapsulated" within objects 50, 52, 54. However, the  
28 steps have not been encapsulated within the objects 50, 52, 54 (i.e., "encapsulating said steps ...  
29 in order to make a reusable data object"). The translator, which allegedly performs these steps, is  
30 not encapsulated and is not within a reusable data object used with a reusable control.

1

2 The Examiner then asserted the following:

3 Furthermore, the Examiner notes, applicant claims, "encapsulating said steps of initializing and  
4 identifying in order to make a reusable data object", wherein the Examiner has shown above, that  
5 there is an encapsulated system, which includes the argued "identifying" and the unequivocal  
6 reusable data objects as the above objects are distributable among applications. In addition to the  
7 above, the Examiner notes that there are parameters that are initialized to identify a plurality of  
8 variables comprising at least the source and target language (there are parameters that contain  
9 variables that identify a source and target language, see Fig 2 items 12, 14, 48, 40, 42, 44), also  
10 sufficient to teach applicant's claimed invention.

11  
12 Although the Examiner may have shown an "encapsulated system" (i.e., the entirety of multi-  
13 lingual data processing system 10), the Examiner has failed to show that the steps of initializing  
14 and identifying being encapsulated into a reusable data object. The objects 50, 52, 54 described  
15 by Hamann do not encapsulate these steps. Thus, for the reasons submitted above, the  
16 Examiner's has continued to fail to establish that Hamann identically discloses the claimed  
17 limitations at issue.

18

For the reasons set forth in the Appeal Brief of February 5, 2008, and for those set forth herein, Appellant respectfully solicits the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. § 102.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: July 14, 2008

Respectfully submitted,

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